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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/725,394

11/29/2000

Wesley W. Whitmyer JR.

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EXAMINER

ALAM, SHAHID AL

ART UNIT

PAPER NUMBER

2162

DATE MAILED: 05/22/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/725,394

Applicant(s)

WHITMYER, WESLEY W.

Examiner

Shahid Al Alam

Art Unit

2162

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 17 January 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 November 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Response to Arguments***

1. Applicant's arguments filed on January 17, 2006 have been fully considered but they are not persuasive for the following reasons.

Applicant argues that the license from 300 taught by the Fucarile patent is not at all analogous to a recordation form; nowhere does the Fucarile patent teach or suggest, in Figure 4 or elsewhere, a database of recordation forms and neither the Schneider patent nor the Fucarile patent teach, disclose or suggest a database containing a plurality of recordation forms as required by all the claims of the present application.

Examiner respectfully disagrees all of the allegations as argued.

Examiner is entitled to give claim limitations their broadest reasonable interpretation in light of the specification.

#### **Interpretation of Claims-Broadest Reasonable Interpretation**

During patent examination, the pending claims must be 'given the broadest reasonable interpretation consistent with the specification.' Applicant always has the opportunity to amend the claims during prosecution and broad interpretation by the examiner reduces the possibility that the claim, once issued, will be interpreted more broadly than is justified. *In re Prater*, 162 USPQ 541,550-51 (CCPA 1969).

In response to applicant's argument that Fucarile patent is non-analogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir.

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1992). In this case, please see the rejection of claim 1. Further, Fucarile teaches Licensing system same as Intellectual Property system and hence, Fucarile reference is an analogous art same as Instant application. Fucarile discloses in Figure 4 a License Server and License Database and its corresponding text teaches the License form which will contain at least a portion of the encoded information. Fucarile discloses form similar to instant application. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, it would have been obvious to a person of ordinary skill in the art at the time of the invention was made to combine the teachings of Fucarile with the teachings of Schneider to enable the system which can be adapted to hold license records (recordation form) and receive and store access information such as number of accesses, user information and the

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license server can then generate usage reports that can be used to determine licensing requirements.

For the above reasons, Examiner believed that rejection of the last Office action was proper.

***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1 – 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Number 5,987,464 issued to Eric Schneider (hereinafter "Schneider") and in view of U.S. Patent Number 6,766,305 issued to Lori J. Fucarile et al. (hereinafter "Fucarile").

With respect to claim 1, Schneider discloses a system for automating the recordation of a property transfer comprising:

an Internet server (Figure 8, item 302 and corresponding text);

a communications link between said Internet server and the Internet (Figure 8, item 144 and corresponding text);

at least one database (Figures 11 and 12a, item 350 and corresponding text) containing a plurality of information records accessible by said Internet server, each

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information record including an intellectual property identification number (Figures 11 and 12a, item 350 and corresponding text);

software executing on said Internet server for receiving a transfer request indicative of a transfer of rights to the property (column 15, line 52 - column 16, line 33).

Schneider does not explicitly disclose software executing on said Internet server for querying said database of information records to retrieve an information record corresponding to a transfer request for querying said database of recordation forms to retrieve a recordation form corresponding to said transfer request and for combining the retrieved information record with the retrieved recordation form to generate a document as claimed.

Fucarile discloses claimed software executing on said Internet server for querying said database of information records to retrieve an information record corresponding to a transfer request for querying said database of recordation forms to retrieve a recordation form corresponding to said transfer request and for combining the retrieved information record with the retrieved recordation form to generate a document (col. 8, lines 62 to col. 9, lines 42).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time of the invention was made to combine the teachings of Fucarile with the teachings of Schneider to enable the system which can be adapted to hold license records (recordation form) and receive and store access information such as number of accesses, user information and the license server can then generate usage reports that can be used to determine licensing requirements (column 3, lines 62 – 67).

With respect to claims 3 and 8, further to the teachings of above claim 1, Schneider and Fucarile teach at least one database containing a plurality of information records accessible by said Internet server, each information record including an intellectual property identification number and a jurisdiction identifier (Figures 11 and 12a and corresponding text; Schneider);

software executing on said Internet server for receiving a transfer request indicative of a transfer of rights to the property (92, fig. 4, Schneider).

software executing on said Internet server for transmitting said property transfer request form through the Internet (34, fig. 12, Schneider);

software executing on said Internet server for receiving a reply to said property transfer request form (col. 9, lines 10-22, Fucarile);

software executing on said Internet server for transmitting said transfer document through the Internet (92, fig. 4, Schneider); and

software executing on said Internet server for updating said database containing a plurality of information records (34, fig. 5 and col. 7, lines 38-47, Schneider).

As to claims 2, 4 and 9, further to the rejections of claims 1, 3 and 8 above, Schneider discloses property is intellectual property such as patents, copyrights, and trademarks (col. 16, lines 14-63).

As to claims 5 and 6, further to the rejection of claim 3 above, Schneider discloses software executing on said Internet server for receiving and transmitting an executed transfer document (col. 16, lines 34-64).

As to claim 7, further to the rejection of claim 3 above, Fucarile teaches software

executing on said Internet server for transmitting said executed transfer document to a property recordation authority (col. 9, lines 10-22).

As claim 10, further to the rejection of claim 8 above, Schneider discloses software executing on said internet server for retrieving said updated to said database containing a plurality of information records through the internet from a plurality of sources (34, fig. 5 and col. 7, lines 38-47).

### ***Conclusion***

3. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.




**Contact Information**

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shahid Al Alam whose telephone number is (571) 272-4030. The examiner can normally be reached on Monday-Thursday 8:00 A.M.- 4:00 P.M..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John E. Breene can be reached on (571) 272-4107. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Shahid Al Alam  
Primary Examiner  
Art Unit 2162

13 May 2006